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**PATENT APPLICATION**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q64919

Kyoko KIMPARA, et al.

Appln. No. 09/880,045

Group Art Unit: 3629

Confirmation No. 5944

Examiner: Igor N. BORISSOV

Filed: June 14, 2001

For: CONTENTS CONVERSION FEE CHARGING SYSTEM, CONTENTS  
CONVERSION FEE CHARGING METHOD AND STORAGE MEDIUM STORING  
PROGRAM FOR CONTROLLING SAME

**AMENDED APPEAL BRIEF UNDER 37 C.F.R. § 41.37.**

**MAIL STOP APPEAL BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, and in response to the Office Action of July 26, 2005, Appellant submits the following amended Brief. The Brief has been amended only to include a Related Proceedings Appendix.

**Table of Contents**

I.	REAL PARTY IN INTEREST .....	2
II.	RELATED APPEALS AND INTERFERENCES .....	3
III.	STATUS OF CLAIMS .....	4
IV.	STATUS OF AMENDMENTS .....	5
V.	SUMMARY OF THE CLAIMED SUBJECT MATTER .....	6
VI.	GROUND OF REJECTION TO BE REVIEWED ON APPEAL .....	9
VII.	ARGUMENT .....	10
	CLAIMS APPENDIX.....	18
	EVIDENCE APPENDIX:.....	25
	RELATED PROCEEDINGS APPENDIX .....	26

**I. REAL PARTY IN INTEREST**

The real party in interest is NEC CORPORATION by virtue of an assignment executed by Kyoko Kimpara and Mitsugu Miura (hereinafter “Appellants”) on June 4, 2001 and recorded in the U.S. Patent and Trademark Office on June 14, 2001 at Reel 011917, Frame 0187.

**II. RELATED APPEALS AND INTERFERENCES**

Upon information and belief, there are no other prior or pending appeals, interferences, or judicial proceedings known to Appellant, Appellant's representatives or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in this appeal.

### **III. STATUS OF CLAIMS**

Claims 3-7 and 9 are pending (*see* Claims Appendix). These claims stand rejected and are the basis for this appeal. Claims 1, 2, and 8 have been canceled.

**IV. STATUS OF AMENDMENTS**

No Amendment has been filed after the final rejection of the claims in the September 29, 2004 Office Action.

**V. SUMMARY OF THE CLAIMED SUBJECT MATTER**

The present invention relates to a contents conversion fee charging system, method thereof, and storage medium for storing a program for controlling contents conversion fee charging system. Claims 3, 6, and 9 are the independent claims and their features are described herein. These claims recite, *inter alia*, a contents provider terminal, a contents server, a user terminal, and a conversion server. Referring to Fig. 1 of the present application, in one embodiment of the invention, the contents provider terminal is shown as item 40, the contents server is shown as item 50, the user terminal is shown as item 60, and the conversion/translation server is shown as item 70.

The contents provider terminal 40 is configured to provide the contents server 50 with contents in which a translation instructing banner including conversion implementing request information is arranged. The contents provider terminal 40 is made up of, for example, a personal computer or a like and is used to store contents 51 to be translated (for example, from English to Japanese) in the contents server 50, and to register contents information containing at least URL (Uniform Resource Locator) information about the contents 51 and contents provider information I40 showing a method of charging for translation of the contents, on the translation server 70, based on manipulation of the contents provider and inputs contents provider information I71 registered on the translation server 70 and translation fee information I77 about the contents translation, from the translation server 70 (see present specification at page 14, 1<sup>st</sup> paragraph, lines 12-23). The contents server 50 stores contents 51 provided by the contents provider and transmits contents 51 to the translation server 70, by request of the conversion

server 70 based on an instruction of a translation instructing banner 61. A translation instructing banner 52 is arranged and contained in the contents 51 by the contents provider, whereby the translation instructing banner 52 is acquired by user terminal 60 and displayed thereat as the translation instructing banner 61 (see present specification at page 14, 1<sup>st</sup> paragraph, lines 24-27).

The user terminal 60 is made up of, for example, a personal computer or a like and is used to select and display contents 51 stored in the contents server 50, by manipulation of the user and, based on an instruction of the translation instructing banner 61, transmits translation implementing request information I60 to make a request of the translation server 70 for the translation of the displayed contents 51 to the translation server 70, and to input and display a translated result I73a of the contents 51 (see present specification at page 15, 1<sup>st</sup> paragraph, lines 3-10).

The translation server 70 is made up of, for example, a work station or a like and has a contents registering device 71, a contents registered database 72, a translation request controlling device 73, a DB reference controlling device 74, a translation processing storing device 75, a translation device 76, a translation fee calculating/notifying device 77, a central processing device (CPU 78), and a storage medium (for example, ROM 79 (Read Only Memory)). The contents registering device 71 performs registration of the contents provider information I40. The contents registered DB 72 registers the contents provider information I40 (see present specification at page 15, 2<sup>nd</sup> paragraph, lines 11-21).

The translation request controlling device 73 refers to the contents registered DB 72, and if the contents 51 corresponding to translation implementing request information I60 proves to

be those to be translated by the reference, acquires contents 51 from the contents server 50, transmits an instructing signal I73b to instruct the translating device 76 to translate the contents 51, together with the contents 51 and transmits results I76 obtained by translating the contents 51 fed from the translating device 76 to the user terminal 60 (see present specification at page 15, 3rd paragraph, line 22 to page 16, line 2).

A translation fee calculating/notifying device 77 transmits translation fee information I77 obtained by referring to the contents registered DB 72 and the translation processing storing device 75 and by calculating the translation fee, to the contents provider terminal 40 in order to charge the contents provider for the translation fee (see present specification at page 16, 2<sup>nd</sup> paragraph, lines 17-22).



**VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL**

Claims 3-7 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ito (U.S. Patent No. 6,330,529) and Tso et al. (U.S. Patent No. 6,421,733) and further in view of Furst (U.S. Patent No. 6,297,819) and Yates et al. (U.S. Patent No. 6,330,586).

## VII. ARGUMENTS

### I. The Prior Art Does Not Teach a Translation Instructing Banner as recited in the Independent Claims.

Independent claims 3, 6, and 9 each recite a translation instructing banner. A non-limiting description of this translation instructing banner can be found on page 14, line 23 to page 15, line 10 of the present specification. In particular, the contents server 50 stores contents 51 provided by the contents provider and transmits contents 51 to the translation server 70, by request of the conversion server 70 based on an instruction of a translation instructing banner 61. A translation instructing banner 52 is arranged and contained in the contents 51 by the contents provider, whereby the translation instructing banner 52 is acquired by user terminal 60 and displayed thereat as the translation instructing banner 61. The user terminal 60 is made up of, for example, a personal computer or the like and is used to select and display contents 51 stored in the contents server 50, by manipulation of the user and, based on an instruction of the translation instructing banner 61, transmits translation implementing request information 160 to make a request of the translation server 70 for the translation of the displayed contents 51 to the translation server 70, and to input and display a translated result I73a of the contents 51.

The Examiner submits on page 4 of the September 29, 2004 Office Action that in response to Appellants argument above that the prior art does not teach a translation instructing banner, it is noted that Furst teaches showing subscription related information on a display (citing column 10, lines 26-28). Furthermore, the Examiner explains that Furst teaches displaying said information in a rectangular window (citing Fig. 1). The Examiner notes that a

banner is a generally square or rectangular boxes provided with some combination of graphics, color and text. Displaying information in a rectangular window in Furst, as argued by the Examiner, obviously indicates displaying said information in a banner-type window. As such, the Examiner concludes that information as to the specific content of displayed information is non-functional language and given no patentable weight. Non-functional descriptive material cannot render non-obvious an invention that would otherwise have been obvious. The Examiner refers to *In re Gulack* 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); and *In re Dembiczak* 175 F.3d 994, 1000, 50 USPQ2d 1614, 1618 (Fed. Cir. 1999). The Examiner states that the specific example of non-functional descriptive material is provided in MPEP 2106, Section VI: (example 3) a process that differs from the prior art only with respect to non-functional descriptive material that cannot alter how the process steps are to be performed.

Appellants respectfully traverse this argument. First, Appellants disagree that the recitation is nonfunctional descriptive material. The Board will note that the claim recites “a translation instructing banner *including conversion implementing request information.*” The Examiner has not addressed, nor would the general disclosure of a rectangular window suggest this feature. Further, the Examiner will note in the same citation of MPEP 2106, that Office Personnel should be prudent in applying this type of rejection since other functional and structural interrelationships may exist. The Board will kindly note that the independent claims also include a feature of “conversion of the displayed contents in accordance with an instruction *through the translation instructing banner ...*” Thus, the claim also provides an interrelationship feature as discussed in MPEP 2106. Both of these instances quite clearly show that the

Examiner's basis for rejection of the claims is improper. In addition, the rectangular window of Furst would not suggest these features.

## II. The Rejection of the Claims Is Based on Hindsight

In addition to the translation instructing banner, Appellants submit that other features recited in the claims are not found in the cited art. Ito is generally related to a translation system. With respect to the claims, the Examiner states that Ito teaches a grammar based translation system and method, comprising an information providing apparatus (citing column 3, lines 57-60); a contents server to store contents provided by a contents provider (citing column 3, lines 57-60); a user terminal to be operated by a user (citing column 3, lines 60-63); and a translation computer system (citing column 4, lines 8-25).

The Examiner does, however, acknowledge that Ito does not teach the feature recited in the independent claims whereby a contents provider is charged a conversion fee for contents conversion performed by the conversion server. Yet, the Examiner further argues that Tso et al. teach a system and method for dynamically transcoding data transmitted between computers, wherein web-page content is translated to a user's native language (citing column 8, lines 42-43 and col. 16, lines 36-38); and wherein a web-site provider (owner) pays a proxy provider to improve the performance of all users (*sic*) while visiting the provider's (owner's) site (citing column 16, lines 36-38). Thus, the Examiner alleges that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito to include a feature whereby the contents provider is charged a fee for contents conversion performed by the translation computer system, because it would increase the amount of potential (foreign-

speaking) customers for the content provider, and generate funds for an owner of the translation computer system, which (funds) are necessary to operate the business.

Appellants respectfully submit that the Examiner's obviousness rejection is based on improper hindsight and also mischaracterizes the teachings of Tso et al. As can be seen by the Examiner's rejection, the motivation to combine the Ito translation system with the Tso et al. transcode service provider was not provided by the Ito patent, by Tso et al., or otherwise. In fact, Appellants submit that Ito is silent with respect to any discussion of charging conversion (translation) fees.

With respect to Tso et al., the citations that the Examiner refers to are paying a proxy provider to improve the performance of the users (*sic*) while visiting the owner's site. The concept of improving a user's performance is earlier described in col. 16 as giving users a higher priority when competing with other users for proxy services (see col. 16, lines 15-23), rather than servicing them on a random or first come/first-served basis. Thus, the concept suggested by Tso et al. is providing preferential treatment (VIP treatment (see col. 16, lines 17 and 18)) when accessing proxy services. For example, one of ordinary skill in the art would have understood that the citation of a web site owner paying a proxy provider in the *full context* of the teachings of Tso. et al. would mean, based on the use of the terms "all users" that the website owner would pay a fee to have the proxy server service the users to its website in a manner faster than that of users requesting access to another website. Tso et al. also teach that users themselves may pay for the service, therefore teaching away from the present invention (see col. 16, lines 33-36). Thus, the passing mention in Tso et al. of a *payment* for preferential treatment (an entirely

different concept and not suggestive of charging a conversion fee) coupled with Tso et al. also teaching (away) that the user pay for preferential treatment does not disclose or suggest the recited feature of charging a conversion fee, nor therefore would there be motivation to incorporate the Tso et al. transcode service provider with the Ito translation system.

In addition, the motivation to combine the Ito translation system with the Tso et al. transcode service provider is not suggested by the nature of the problem to be solved. *See Pro-Mold v. Great Lakes Plastics*, 75 F.3d 1568, 1573 (Fed. Cir. 1996). One of the problems solved by the present invention is the inconvenience and costs associated with charging translation fees directly to a user (see specification at page 4). As such, one of the features of the present invention, as recited in the independent claims, is *charging* the content provider for contents conversion performed by the conversion server.

In Ito, the problem solved is providing a translation system that allows a converted document to be further worked on after it has been converted and displayed on a user screen (see col. 1, lines 24-50). Again, for the reasons discussed above, Ito does not teach or suggest the feature of charging for a conversion fee.

Tso et al. solves the problem of existing (at the time) proxy servers not being able to manipulate data passing through them. As discussed above, Tso et al. provides only a passing mention of a “pay” feature that is certainly not related in any manner to the problem solved by Tso et al.

Appellants note that the Federal Circuit warns about the risk of hindsight reconstruction to find an invention obvious where the invention at issue involves relatively simple technology. *See*

*McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351 (Fed. Cir. 2001). Even, *assuming arguendo*, that the individual features were disclosed in parts of each patent, since the motivation to combine the individual features is not found in the disclosure of the patents themselves, or by the problem they solve, Appellants respectfully submit that the rejection is based on hindsight using the Appellants' own specification, which is improper. Accordingly, Appellants submit that claims 3-7 and 9, each including the conversion fee charging system feature are allowable for this reason as well.

Further, the Examiner acknowledges that Ito and Tso et al. do not teach showing a method of charging for conversion of said contents; registering said contents information and contents provider information; and collecting use history information for determining said conversion fee. The Examiner states that Furst teaches a system and method for translating a web-page from its native language into a desired language (citing column 11, lines 65-67), wherein service providers are registered with the system (citing column 6, lines 52-55), and wherein payment options (subscription information) are shown on a display (citing column 10, lines 26-28). Based on this disclosure, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito and Tso et al. to include registering service providers with the system as taught by Furst, because it would allow a record of services offered as subscriptions for the users. Appellants respectfully traverse this assertion.

As recited in the claims, the contents information and the contents information provider are registered on the conversion server. While Furst discusses a general concept of registration,

this registration is related to registering applications (see col. 2, lines 5-30 for an explanation of applications) - not to content information.

In addition, the Examiner states that Yates et al. teach a system and method for service provision by means of communications networks, wherein usage record and accrued charges are monitored (citing column 19, lines 49-50). Therefore, the Examiner states that it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Ito, Tso et al. and Furst to include monitoring of usage, as taught by Yates et al., because it would allow to provide discounts for said subscriptions to the most frequent users thereby stimulating the users to increase their usage time and profits to the system owners. Appellants respectfully submit that based on the lack of teachings of the invention by Ito, Tso et al. and Furst for the reasons above, that the addition of a generic reference to usage records in Yates et al. would not render the present invention obvious. Accordingly, Appellants submit that claims 3-7 and 9 are allowable for the reasons discussed above.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.



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U.S. Application. No. 09/880,045

Attorney Docket Q64919

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CUSTOMER NUMBER

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**CLAIMS APPENDIX**

CLAIMS 3-7 and 9 ON APPEAL:

3. A contents conversion fee charging system comprising:

a contents provider terminal;

a contents server;

a user terminal; and

a conversion server,

wherein said contents provider terminal is configured to provide said contents server with contents in which a translation instructing banner including conversion implementing request information is arranged, and to provide said conversion sever with contents provider information including contents information and charging method information showing a method of charging for conversion of said contents, such that said contents provider information is registered on said conversion server, and to receive conversion fee information about conversion of said contents from said conversion server,

wherein said contents server is configured to store said contents provided by said contents provider terminal, and to transmit said stored said contents to said conversion server by request of said conversion server,

wherein said user terminal is configured to select and display said contents stored in said contents server, to transmit to said conversion server conversion implementing request information used to make a request of said conversion server for conversion of the

displayed contents, in accordance with an instruction through said translation instructing banner and to input results of conversion of said contents from said conversion server and display the input results of conversion of said contents,

and wherein said conversion server is configured to acquire said contents from said contents server and convert the acquired contents, based on said conversion implementing request information received from said user terminal, and to transmit said results of conversion of said contents to said user terminal, and to register use history information representing conversion history of contents, and to produce conversion fee information by calculating a conversion fee based on both the registered contents provider information and use history information, and to transmit said conversion fee information to said contents provider terminal in order to charge said a contents provider for conversion fees.

4. The contents conversion fee charging system according to Claim 3, wherein said conversion server has a contents registering device, a contents registered database, a conversion request controlling device, a database reference controlling device, a conversion processing storing device, a conversion device, and a conversion fee calculating notifying device,

wherein said contents registering device is configured to perform registration processing of said contents provider information, and wherein said contents registered database is so configured to register said contents provider information,

wherein said conversion request controlling device is configured to refer to said contents

registered database, and to acquire from said contents server contents corresponding to said conversion implementing request information, when said contents are those to be converted, by the reference, and to instruct said conversion device to perform said conversion of acquired said contents and to transmit results of said conversion of said contents performed by said conversion device to said user terminal,

wherein said database reference controlling device is configured to check, in response to a reference from said conversion request controlling device, whether said contents to be converted have been registered on said contents registered database and, when said contents have been registered, to permit said conversion request controlling device to perform said conversion of said contents and, after conversion, to transmit information that the conversion has and been performed to said conversion processing storing device as said use history information,

wherein said conversion processing storing device is configured to store said use history information,

wherein said conversion device is configured to perform said conversion of said contents to be converted and to transmit results of said conversion to said user terminal, and

wherein said conversion fee calculating and notifying device is configured to produce said conversion fee information by referring to said contents registered database and said conversion processing storing device and by calculating said conversion fee and to transmit said conversion fee information to said contents provider terminal in order to charge said contents provider for said conversion fee.

5. The contents conversion fee charging system according to Claim 3, wherein, in said conversion, said contents, when being described in a foreign language, are translated into contents described in a native language of a user.

6. A method of charging contents conversion fee employed in a contents conversion fee charging system made up of a contents provider terminal, a contents server, a user terminal, and a conversion server, comprising:

contents providing processing in which said contents provider terminal provides said contents server with contents in which a translation instructing banner including conversion implementing request information is arranged,

contents provider information registering processing in which said contents provider terminal provides said conversion server with contents provider information including contents information and charging method information showing a method of charging for conversion of said contents, such that said contents provider information is registered on said conversion server;

contents storing processing in which said contents server stores said contents provided by a contents provider,

contents transmitting processing in which said contents server transmits said stored contents to said conversion server by request of said conversion server,

contents displaying processing in which said user terminal selects and displays said contents stored in said contents server;

conversion request processing in which said user terminal transmits conversion implementing request information used to make a request of said conversion server for the displayed contents in accordance with an instruction through said translation instructing banner;

converting processing in which said conversion server refers to said contents registered database, and then acquires said contents from said contents server and converts the acquired contents, based on said conversion implementing request information received from said user terminal, and registers information that said conversion has been performed as use history information on a storing device;

conversion result transmitting processing in which said conversion server transmits said results of conversion of said contents to said user terminal,

conversion result displaying processing in which said user terminal inputs results of conversion of said contents from said conversion server and displays the input results of conversion of said contents;

conversion fee information transmitting processing in which said conversion server produces conversion fee information by calculating said conversion fee based on both the registered contents provider information stored in said contents registered database and use history information registered on said conversion processing storing device, and transmits said conversion fee information produced to said contents provider terminal;

conversion fee information inputting processing in which said contents provider terminal inputs said conversion fee information through said conversion server; and

conversion fee charging processing in which said contents provider terminal charges said contents provider for said conversion fee, based on said conversion fee information.

7. The method of charging contents conversion fee according to Claim 6, wherein, in said conversion, said contents, when being described in a foreign language, are translated into contents described in a native language of a user.

9. A storage medium storing a control program to cause a computer to implement functions of a contents conversion fee charging system, said system comprising:

a contents provider terminal;

a contents server;

a user terminal

a conversion server; and

wherein said contents provider terminal is configured to provide said contents server with contents in which a translation instructing banner including conversion implementing request information is arranged, and to provide said conversion server with contents provider information including contents information and charging method information showing a method of charging for conversion of said contents, such that said contents provider information is registered on said conversion server, and to receive conversion fee information about conversion of said contents from said conversion server,

wherein said contents server is configured to store said contents provided by said contents provider terminal, and to transmit said stored contents to said conversion server by request of said conversion server,

wherein said user terminal is configured to select and display said contents stored in said contents server, to transmit to said conversion server conversion implementing request information used to make a request of said conversion server for conversion of the displayed contents, in accordance with an instruction through said translation instructing banner and to input results of conversion of said contents from said conversion server and display the input results of conversion of said contents,

and wherein said conversion server is configured to acquire said contents from said contents server and convert the acquired contents, based on said conversion implementing request information received from said user terminal and to transmit said results of conversion of said contents to said user terminal, and to register use history information representing conversion history of contents, and to produce conversion fee information by calculating a conversion fee based on both the registered contents provider information and use history information, and to transmit said conversion fee information to said contents provider terminal in order to charge a contents provider for conversion fees.



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**EVIDENCE APPENDIX:**

NONE.

**RELATED PROCEEDINGS APPENDIX**

NONE.